

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex part PETER T. AYLWARD,  
ROBERT P. BOURDELAIS  
and THADDEUS S. GULA

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Appeal No. 2002-1567  
Application No. 09/197,729

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ON BRIEF

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Before WARREN, KRATZ and MOORE, Administrative Patent Judges.  
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 2, 5, 7-15, 17 and 18 as amended after final rejection, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a photographic element with a voided cushioning layer having specified compression and recovery properties. The cushioning layer is located below an

imaging layer. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A photographic element comprising a reflective color print material comprising at least one silver halide containing imaging layer and a voided cushioning layer below said at least one imaging layer having a compression percentage of between 5 and 25% and wherein the recovery percentage is between 50% and 100% of the amount compressed and said photographic element has a base below said cushioning layer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ashcraft et al. (Ashcraft)	4,377,616	Mar. 23, 1983
Aylward et al. (Aylward)	5,888,643	Mar. 30, 1999 (filed May 23, 1997)

Claims 1, 2, 5, 7-15, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aylward in view of Ashcraft.<sup>1</sup>

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

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<sup>1</sup> The examiner also refers to claim 4 as rejected; however, claim 4 was cancelled. See the amendment filed September 11, 2000.

OPINION

Having carefully considered each of appellants' arguments set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejection for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

Appellants (brief, page 2) have identified two groups of claims with claims 1, 2, 5-12, 17 and 18 being grouped together.<sup>2</sup> We select independent claim 1 as the representative claim on which we shall decide this appeal with respect to the first named grouping of claims. See 37 CFR § 1.192(c)(7) (1997). We shall select claim 13 as the representative claim and shall consider the patentability of the second grouping of claims 13 and 14 separately only to the extent that claim grouping has been separately argued by appellants in a manner consistent with 37 CFR § 1.192(c)(7) and (c)(8)(iv) (1997).

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<sup>2</sup> Claim 6 was cancelled in an amendment filed April 19, 2000 and appellants did not include dependent claim 15 in either claim grouping. Since claim 15 depends from claim 1 and appellants did not separately argue claim 15 or disagree with the examiner's suggestion (answer, page 2) that claim 15 be included in the first claim grouping, we shall consider the patentability of claims 1, 2, 5, 7-12, 15, 17 and 18 as rising or falling together.

As essentially found by the examiner (answer, pages 3 and 4), Aylward, like appellants, discloses a photographic material or element that includes a biaxially oriented thermoplastic polyolefin polymer sheet (core) that includes microvoids. Polymer layer(s) including the core voided sheet are laminated to a paper base and are located below a silver halide containing imaging layer as part of an underlayer support therefore. See, e.g., the abstract, column 2, lines 10-39, column 3, lines 7-67, column 5, line 66 through column 6, line 2, column 7, lines 34-42 and column 9, line 52 through column 10, line 21 of Aylward. Given that Aylward teaches a voided sheet underlayer that substantially corresponds in the manner of making and overall structure to the voided sheet structure disclosed by appellants, the examiner has determined that the voided sheets taught by Aylward<sup>3</sup> would reasonably be expected to possess the compression

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<sup>3</sup> The examiner additionally relies on Ashcraft (U.S. Pat. No. 4,377,616) to show that the voided biaxially oriented sheet of Aylward would be expected to possess the properties that appellants' claim their voided layer possesses. In this regard, we observe that Aylward incorporates by reference the disclosure of Ashcraft as well as two other patents in discussing the type of voided sheets useful in Aylward and how they are manufactured. Significantly, at page 3 of their specification, appellants point to the same patents, including U.S. Patent No. 4,377,616 to Ashcraft, as referred to by Aylward for a disclosure as to how appellants' micro voided sheets are formed.

percentage and recovery percentage properties set forth in representative claim 1. We agree.

Appellants argue, in effect, that the examiner has not established, prima facie, that one of ordinary skill in the art would have been led to employ the teachings of Ashcraft in combination with Aylward and that the voided biaxially oriented sheet containing photographic element of Aylward would not, in fact, possess the cushioning properties (compression percentage and recovery percentage) as recited in representative appealed claim 1. See pages 3-6 of the brief and the reply brief. We disagree with those contentions of appellants.

As for the combinableness of Ashcraft with Aylward, we note that the incorporation by reference of the disclosure of Ashcraft in Aylward makes plain that Ashcraft's description of the voided sheet is not only combinable with but part of the disclosure of Aylward. Moreover, we note that the functional characteristics that appellants recite for the claimed product do not serve to distinguish the claimed product from the applied prior art given the commonalities between Aylward's patent and appellants' specification in describing how a voided layer is constructed. Whether a rejection is under 35 U.S.C. § 102 or § 103, when appellants' product and that of the prior art appears to be

identical or substantially identical as is the case here, the burden fairly shifts to appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics of appellants' claimed product. See In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See Best, 562 F.2d at 1255, 195 USPQ at 434.

While appellants seemingly urge that some selection in manufacturing may be required in achieving the claimed cushioning properties, appellants have not substantiated that argument by way of test results or by otherwise showing that the products suggested by Aylward would not have the claimed cushioning characteristic. Indeed, such arguments of counsel have little merit since actual test results fairly comparing appellants' product with the product of Aylward have not been furnished. Consequently, the record of this application does not establish that there would have been any difference in the cushioning performance of appellants' product and that of Aylward.

In this regard, to the extent appellants may have recognized another potential advantage of the product suggested by Aylward that would have been obtained by otherwise following the teachings of the patent, that recognition does not necessarily form a basis for patentability. See In re Woodruff, 919 F.2d 1575, 1577-1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). The choice to emphasize different terminology or characteristics in describing a product does not, by itself, render such a product patentable. See In re Skoner, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975). We further note that inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art since artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

Given the above, we do not find appellants unsubstantiated arguments persuasive as to a patentable distinction between the product of representative claim 1 and that of Aylward. Accordingly, on this record, we shall sustain the examiner's § 103 rejection of claims 1, 2, 5, 7-12, 15, 17 and 18.

With regard to the Group 2 claims (dependent claims 13 and 14), appellants acknowledge that Aylward generally discloses the

product construction specified in those claims. See page 6 of the brief. Appellants only argument with respect the second claim grouping relates to the cushioning properties specified in claim 1. Consequently, it follows that we shall also sustain the examiner's § 103 rejection of claims 13 and 14.<sup>4</sup>

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<sup>4</sup> We note that claims 13 and 14, as well as claims 5, 7, 8, 9 and 18 ultimately depend from canceled claim 4. Thus, in the event of further prosecution of those claims, the examiner and appellants should resolve that improper dependency.



CONCLUSION

The decision of the examiner to reject claims 1, 2, 5, 7-15, 17 and 18 under 35 U.S.C. § 103 as being unpatentable over Aylward in view of Ashcraft is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JAMES T. MOORE	)	
Administrative Patent Judge	)	

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APJ KRATZ

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APJ

DECISION: **ED**

Prepared By:

**DRAFT TYPED:** 21 Jan 04

**FINAL TYPED:**